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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/834,625

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Takashi Yokota

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04/20/2006

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EXAMINER

CUFF, MICHAEL A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,625

Applicant(s)

YOKOTA, TAKASHI

Examiner

Michael Cuff

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

35 USC § 112 withdrawn

The examiner concurs with applicant's argument with regards to only an inventor may file a patent application. As a minor issue, please remove the capitalization from "Patent Office" in the current claims to ensure that it is clear that applicant is claiming a generic patent office and not the United States Patent Office.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong in view of United States Code Title 35 - Patents.

Wong shows all of the limitations of the claims except for specifying filing an application and presenting a purchase offer

Wong shows an integrated business-to-business web commerce and business automation system. From the abstract, "The effect of such integration on the business cycle (this includes buyers and sellers, who are third party traders to each other, along with their offers and accepting of offers and purchasing and transfer of ownership) is profound allowing the sale of virtually anything (this includes intellectual property) in a transactional context (goods, services, insurance, subscriptions, etc.) to be drastically

streamlined.” The Wong system provides a relational database, on which products are registered. The firewall insures licit sellers. The system operates on the Internet and therefore the system encompasses all terminals connected to the Internet, including a trader’s terminal unit and a Patent Office.

The Wong reference emphasizes the automation of an on-line business-to-business system and uses a seller-side system as an embodiment. Wong shows (Column 3, lines 51-58) software enabling business-to-business transactions, buyer-side and seller-side procurement, consumer on-line Internet storefronts, and commercial Internet publishing in order to accommodate different business needs. The Wong database management system can support any of the above business models in order to streamline the transactions.

Based on the discussion above, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to expand the method of using the Wong system to different business models including buyer-side procurement (buyer side procurement includes purchase offers in order to accommodate different business needs.

United States Code Title 35 – Patents teaches that one has the right to file an application for a patent on intellectual property in order to protect the intellectual property.

Based on the teaching of United States Code Title 35 – Patents, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to expand the method of using the Wong system in that if a product that was purchased in

the system was intellectual property and was not protected, it would then be obvious to file for a patent in order to protect the intellectual property.

Response to Arguments

2. Applicant was correct in interpreting the examiner's typo of leaving out an "and".
3. Applicant asserts that it is clear from each claim that the trader is not the seller or the buyer. The examiner does not concur. "The trader" is not "the seller" and "the buyer" in applicant's terminology. However, note claim language "purchasing, by the trader" and "selling, by the trader". The trader is both a buyer and a seller in plain English. Therefore, the generic teaching of Wong reads on all three participants.
4. Applicant uses the definition of a firewall to assert that a firewall cannot determine whether a seller is licit. The examiner contends that applicant provided the wrong definition. One of the definitions for "licit" is, per Webster, just "permissible". There are no special definitions in applicant's specification for licit, therefore any reasonable dictionary definition can be applied for the broadest reasonable interpretation. The firewall insures only permissible sellers.
5. Applicant asserts that neither the seller nor the buyer is required to initiate the transaction. This is not relevant because it is not claimed.

6. Applicant asserts that there would be no motivation to combine the references. The examiner does not concur. The examiner believes that if one purchased intellectual property, it would be obvious to protect the intellectual property in order to make money.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (571) 272-6778. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Cuff
April 17, 2006